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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,765	03/20/2001	Masahiro Ohwa	016887-1036	9294

22428 7590 10/07/2004

FOLEY AND LARDNER  
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3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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BAKER, CHARLOTTE M

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/811,765

Applicant(s)

OHWA, MASAHIRO

Examiner

Charlotte M Baker

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Specification*

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

1. The abstract of the disclosure is objected to because the number of words contained exceeds 150. Correction is required. See MPEP § 608.01(b).
2. The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.
3. The disclosure is objected to because of the following informalities: page 9, lines 29-30, replace "HHD" with "HDD"; page 11, line 17, remove "of" in the phrase "both of the timer..."; page 11, line 20, remove "till" and replace with "until"; page 12, line 20, remove "exits" and replace with "exists"; page 14, line 1, remove "exist" and replace with "exists".

Appropriate correction is required.

### *Claim Objections*

4. The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).
5. Claims 6 and 15 are objected to because of the following informalities: page 17, line 7, replace "deal" with "dealt" and page 19, line 16, replace "deal" with "dealt". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*FAW*  
*1-16*  
Claims ~~1 and 2~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata (US 2001/0022670 A1) in view of Sakakibara (4,900,902).

**Regarding claim 1:** Nagata discloses an image forming device (image sensor 13, page 2, lines 16-25) for obtaining text data by scanning a document (original document 11, page 2, par. 32, lines 7-8); an internal storage device (memory 10, page 3, par. 37, lines 1-4) for temporarily saving the confidential text data; a device (mailbox 101) for deleting the confidential text data after a first predetermined time has elapsed (elapsed time of recording in mailbox 101, page 3, par. 45, lines 1-6 through page 4, par. 45, lines 1-8) since a point of time when the confidential text data were temporarily saved on said internal storage device (page 4, lines 16-48).

Nagata fails to specifically address an external storage device and a control unit. Sakakibara discloses an external storage device (card unit 140) for saving data on an attachable/detachable medium (card, col. 6, lines 44-45) and a control unit (main control unit 60) for controlling the whole of said image forming apparatus (col. 2, lines 27-28).. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the memory 10 disclosed by Nagata with the connection of (card unit 140) disclosed by Sakakibara in order to provide

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speedy delivery of confidential communication for a designated person given the suggestion of Sakakibara (col. 7, lines 37-41).

**Regarding claim 2:** Nagata in view of Sakakibara satisfy all the elements of claim 1.

Sakakibara further discloses saving data stored on the internal storage device (image memory 70) and transferred to the external storage device (card unit 140) and the data on the internal storage device (image memory 70) are erased after a completion of data transfer (col. 4, lines 44-45).

**Regarding claim 3:** Nagata in view of Sakakibara satisfy all the elements of claim 2. Nagata discloses saving confidential data to an internal memory 10 and erasing that data at a predetermined time (T, page 2, lines 55-59). Sakakibara teaches a card unit 40 connected to a main controller 1 and a card inserted in the card unit 140. When the card is inserted in card unit 140, the memory 10, which has been modified to include the card unit 140, will send a signal to the card unit 140 to erase the card after a second predetermined time has elapsed.

**Regarding claim 4:** Nagata in view of Sakakibara satisfy all the elements of claim 3.

Sakakibara further discloses after a completion of saving the text data on the storage medium (card unit 140), output a piece of information (display, col. 6, lines 56-66) for prompting a user to pull out said storage medium ("MEMORY FULL").

**Regarding claim 5:** Nagata in view of Sakakibara satisfy all the elements of claim 4.

Sakakibara further disclose the information for prompting the user to pull out said storage medium (card) is a message displayed ("MEMORY FULL") as stated in the rejection of claim 4.

**Regarding claim 6:** Nagata in view of Sakakibara satisfy all the elements of claim 1. Nagata further discloses an operation unit (operating panel 5) for specifying, if the

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document (original document 11) to be dealt with exhibits a high confidentiality, a confidential document mode (confidential transmission mode, page 3, lines 11-14).

**Regarding claim 7:** Nagata in view of Sakakibara satisfy all the elements of claim 1. Nagata further discloses when temporarily saving the confidential text data on the internal storage device (memory 10), executes an authentication process of comparing a user name and a password inputted (keypad 51) with a user name and a password registered beforehand (page 3, lines 15-22).

**Regarding claim 8:** Nagata in view of Sakakibara teach the scanner unit, external storage device, internal storage device, confidential data, and the control unit of claim 1. Nagata in view of Sakakibara also teach the password registration of claim 7, and the erasure of contents on a storage medium of claims 3 and 4. Nagata further discloses a password registration module (reception data area E2) for registering a user name and a password (provides access permission, page 2, lines 43-47).

**Regarding claim 9:** Nagata in view of Sakakibara satisfy all the elements of claim 8. Sakakibara further disclose a control unit (main control unit 60) and if unused capacity of the medium becomes insufficient ("MEMORY FULL") when transferring data from internal storage device to the external storage device prevents the data from being erased by extending time (prompts operator to insert card again, col. 6, lines 46-55).

**Regarding claim 10:** Nagata in view of Sakakibara satisfy all the elements of claim 9.

Arguments analogous to those stated in the rejection of claim 5 are applicable.

**Regarding claim 11:** Nagata in view of Sakakibara teach the structural elements of the apparatus: scanner unit, internal storage device, transfer data from internal storage device to

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external storage device, and erasing contents of internal storage of claim 1. In addition, the structural element of the apparatus, prompting a user to pull out medium of claim 4. The structural elements of the apparatus of claims 1 and 4 perform all the steps of claim 11.

Therefore, claim 11 is rejected for the same reasons discussed in the rejections of claims 1 and 4.

**Regarding claim 12:** Nagata in view of Sakakibara satisfy all the elements of claim 11. The structural elements of the apparatus of claim 2 perform the step of claim 12. Therefore, claim 12 is rejected for the same reasons discussed in the rejection of claim 2.

**Regarding claim 13:** Nagata in view of Sakakibara satisfy all the elements of claim 12. The structural elements of the apparatus of claim 3 perform the step of claim 13. Therefore, claim 13 is rejected for the same reasons discussed in the rejection of claim 3.

**Regarding claim 14:** Nagata in view of Sakakibara satisfy all the elements of claim 11. The structural elements of the apparatus of claim 5 perform the step of claim 14. Therefore, claim 14 is rejected for the same reasons discussed in the rejection of claim 5.

**Regarding claim 15:** Nagata in view of Sakakibara satisfy all the elements of claim 11. The structural elements of the apparatus of claim 6 perform the step of claim 15. Therefore, claim 15 is rejected for the same reasons discussed in the rejection of claim 6.

**Regarding claim 16:** Nagata in view of Sakakibara satisfy all the elements of claim 15. The structural elements of the apparatus of claims 6 (confidential transmission mode) and 7 (password input) perform the steps of claim 16. Therefore, claim 16 is rejected for the same reasons discussed in the rejection of claims 6 and 7.

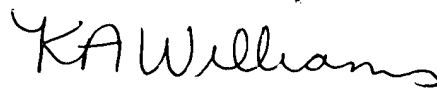
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M Baker whose telephone number is (703) 306-3456. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmb 



**KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER**